

Or transmitting a notification from the sending system to the receiving system signifying to the receiving system that the sending system is transmitting the digital information to the server system and that the digital information may be accessible to the receiving system.

In the drawings:

Please substitute the enclosed 20 sheets of formal drawings for the corresponding drawings presently in the application.

REMARKS

In view of the above amendment and the following remarks, reconsideration and allowance of this application are respectfully requested. Claims 1-32 are pending in the application, with claims 1, 13, and 16 being independent. Claims 13 and 16 have been amended.

Claims 1, 2, 5-11, 13, 16, 17, 19, 23 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bobo (U.S. Patent No. 5,675,507) in view of Kumar (U.S. Patent No. 6,240,445). With respect to claim 1 and claims depending from claim 1, applicant requests reconsideration and withdrawal of this rejection because neither Bobo, Kumar nor any combination of the two describes or suggests having a sending system transmit a notification to a receiving system, with the notification signifying that the sending system is transmitting digital information over a network to a server system, and that the digital information may be accessible by the receiving system at the server system, as recited in claim 1.

The examiner concedes that Bobo "does not explicitly teach that the sending system transmits both the digital information [to the server system] and a notification to the receiving system," and relies on Kumar for this teaching. Kumar discloses transmission of a notification message by a computer 18 that receives a facsimile message:

A facsimile message 12 is transmitted from a transmitting facsimile machine 14 across the public switched telephone network (PSTN) 16 to a computer 18 where the facsimile message 12 is received. Computer 18 may provide storage and forwarding services for a number of subscribers of facsimile message reception system 10. (Col. 4, line 65 – col. 5, line 4.)

Upon receipt of a facsimile message 12, computer 18 forwards a notification message which indicates such reception to the intended recipient. (Col. 5, lines 9-11.)

The notification message may be transmitted across a computer network 22 (e.g., the internet) to the user. (Col. 5, lines 19-20.)

Upon receipt of the notification message, the user ... may choose to have facsimile message 12 down-loaded to a receiving computer 24, a storage medium 26, or a hard copy output device (e.g., a facsimile machine or printer) 28 and/or a combination of these devices. Storage medium 26 may, for example, be included within the receiving computer 24. (Col. 5, lines 29-38.)

Computer 18 is the portion of the system which notifies the user and receives/stores the facsimile messages (i.e., digital information) that may be retrieved later by the user. In contrast, the apparatus recited in claim 1 includes a sending system that transmits a notification to a receiving system, with the notification signifying that the sending system is transmitting the digital information over the network to the server system, and that the digital information may be accessible by the receiving system at the server system. Kumar does not disclose that computer 18 transmits digital information over a network to a server system. Thus, computer 18, like the message and storage system described in Bobo, does not transmit both digital information to the server system and a notification to the receiving system.

Nor does Kumar disclose that computer 18 transmits a notification that the sending system is transmitting the digital information over the network to the server system. Rather, with reference to Figure 1, Kumar generates a notification upon receipt of a facsimile message:

Upon receipt of the facsimile message 12, computer 18 provides notification of such reception to the intended recipient The facsimile message 12 may be sent within the notification message itself, as an attachment thereto, or, preferably it may be stored (e.g., as a web page or, more particularly, as an image viewable or otherwise accessible at a web page) and the notification message may comprise a computer network address (e.g., a URL) indicating where the received facsimile message may be accessed. (Col. 7, lines 20-33.)

In one embodiment, the notification message is transmitted via e-mail and may comprise the facsimile message itself, an e-mail attachment which includes the facsimile message, or a computer network address (e.g., a URL) which identifies or specifies a location (e.g., a web page) at which the received facsimile message may be accessed. The URL may identify a web page associated with the computer or a web page

associated with some other storage device Computer 18 may also include a storage archive for received facsimile messages and the notification message may comprise an address of the storage archive at which a particular stored facsimile message may be accessed. (Col. 8, lines 24-37.)

Thus, Kumar's notification is generated by computer 18 upon receipt of the facsimile message rather than by the sender upon transmission.

In addition, Kumar does not describe or suggest having a sending system transmit a notification to a receiving system, with the notification signifying that the sending system is transmitting digital information over the network to the server system, and that the digital information may be accessible by the receiving system at the server system. In particular, Kumar's storage of the digital information at the sending computer system, even if separate from the computer system itself, does not constitute transmitting digital information over a network from a sending system to a server system, from which the digital information is accessed by a receiving system since, in Kumar's system, the recipients later access messages through the computer 18. See Kuma at col. 5, lines 31-36 and lines 59-65.

For at least these reasons, Kumar does not remedy the failure of Bobo to describe or suggest the subject matter of independent claim 1. Accordingly, applicant requests withdrawal of the rejection of independent claim 1 and claims 2 and 5-11, which depend from claim 1.

Similarly to independent claim 1, amended claims 13 and 16 each recite a sending system that transmits a notification to a receiving system, with the notification signifying that the sending system has transmitted digital information to a server system, and that the digital information may be accessible by the receiving system at the server system. Accordingly, for the reasons noted above with respect to claim 1, applicant requests withdrawal of the rejection of claims 13 and 16, and claims 17, 19, 23 and 27, which depend from claim 16.

Dependent claims 3, 4, 12, 14, 15, 18, 20-22, 24-26 and 28-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bobo (U.S. Patent No. 5,675,507) and Kumar (U.S. Patent No. 6,240,445) in view of Masters (U.S. Patent No. 5,872,930). As discussed above, neither Bobo, Kumar nor any combination of the two describes or suggests a sending system that transmits over a network both a notification to a receiving system and digital

information to a server system from which the receiving system may access the digital information.

Master does not remedy the failure of Bobo and Kumar to describe or suggest the subject matter of independent claims 1, 13 and 16, from which the rejected dependent claims depend. Instead, Masters describes balancing the load or volume of electronic mail across multiple electronic mail servers. See Masters, col. 2, lines 18-34. For at least these reasons, applicant requests withdrawal of the rejection of claims 3, 4, 12, 14, 15, 18, 20-22, 24-26 and 28-32, each of which depends from claim 1, 13 or 16.

Independent claims 1, 13 and 16 also were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent No. 5,790,790) in view of Ishibashi (European Patent Application EP 0 812 100 A2). With respect to claim 1, applicant requests reconsideration and withdrawal of this rejection because neither Smith, Ishibashi, nor any combination of the two describes or suggests having a sending system transmit a notification to a receiving system, with the notification signifying that the sending system is transmitting the digital information over the network to the server system, and that the digital information may be accessible by the receiving system at the server system, as recited in claim 1.

The examiner concedes that Smith does not teach that the sending system transmits both the digital information to a server system and a notification to a receiving system. The examiner relies on Ishibashi to remedy this failure of Smith. However, Ishibashi does not describe or suggest a sending system that transmits to a receiving system a notification signifying that the sending system is transmitting the digital information over the network to the server system, as recited in claim 1.

Specifically, Ishibashi discloses a communication device that sends an electronic mail transmission over a network to a server. See Ishibashi at page 4, line 56 – page 5, line 35. After the transmission of the electronic mail message to the server, the communication device sends a facsimile notification that the electronic mail message has been sent. See Ishibashi at page 6, lines 19-29 and page 7, lines 19-20.

Since the communication device sends the notification facsimile after transmitting the digital information (i.e., the electronic mail message), the notification message necessarily would not signify that the sending system is transmitting digital information that may be accessible at

the server system. Rather, the message would, at best, indicate that the sending system transmitted digital information that may be accessible at the server system.

As such, Ishibashi does not disclose or suggest "a sending system connected to the network and transmitting a notification to the receiving system, the notification signifying that the sending system is transmitting the digital information over the network to the server system and that the digital information may be accessible by the receiving system at the server system," as recited in claim 1, and, accordingly, does not remedy the failure of Smith to describe or suggest the subject matter of claim 1.

For at least these reasons, applicant requests withdrawal of the rejection of independent claim 1.

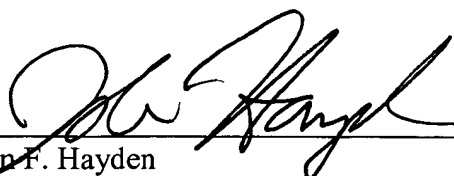
Similarly to independent claim 1, amended claims 13 and 16 each recite a sending system transmitting a notification using a network to a receiving system, with the notification signifying that the sending system is transmitting the digital information over the network to the server system, and that the digital information may be accessible to the receiving system at the server system. Accordingly, for the reasons noted above with respect to claim 1, applicant requests withdrawal of the rejection of claims 13 and 16.

Attached is a marked-up version of the changes being made by current amendment.

Applicant asks that all claims be allowed. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 2/6/03



John F. Hayden
Reg. No. 37,640

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

Version with markings to show changes made

In the claims:

Claim 13 has been amended as follows:

13. (Amended) An electronic document delivery system, comprising:
a server system;
a sending system; and
a receiving system in communication with the server and the sending systems, [and]

wherein:

the sending system transmits digital information to the server system and a notification to the receiving system, the notification signifying to the receiving system that the sending system [has transmitted] is transmitting the digital information to the server system[;], and [wherein]

the receiving system, in response to the notification, can access the server system to obtain the digital information.

Claim 16 has been amended as follows:

16. (Amended) A method for delivering a document from a sending system to a receiving system over a network, comprising the steps of:

transmitting digital information from the sending system to a server system over the network;

storing the transmitted digital information at a storage device associated with the server system; and

transmitting a notification from the sending system to the receiving system signifying to the receiving system that the sending system is transmitting the digital information to the server system and that the digital information may be accessible to the receiving system.